

REMARKS

No amendments to the instant claims are presented via the current response. Claims 2, 8, 10, 15, 17, and 20 have been withdrawn from consideration in a previous Office Action. Applicants respectfully request rejoinder of the withdrawn claims pursuant to M.P.E.P. §821.04 upon the indication of allowable subject matter. Claims 1-20 remain pending in the instant Application and are presented for the Examiner's reconsideration in light of the following comments.

Rejection Under 35 U.S.C. §103

Claims 1, 3-7, 9, 11-14, 16, and 18-19 have been finally rejected under 35 U.S.C. §103(a) over *McCay*, et al., U.S. Patent No. 4,506,575, in view of *Esping*, et al., U.S. Patent No. 6,761,098. Previous arguments made with regard to the *McCay* and *Esping* references remain in effect but will not be repeated for the sake of brevity. Again, Applicants respectfully traverse this rejection and request the Examiner to consider the additional matters that clearly distinguish Applicants' claimed invention over the *McCay* and *Esping* references.

It should be note that the *McCay* reference goes into explicit detail describing the cantilevered support used to support a core. This detail includes a description of a means for securing the core to the cantilevered support (1:44-48). In a nutshell, this additional structure includes a roll stop pin 19 provided to the tube 18 to limit the movement of the core with respect to the tube 18 and position it correctly. (3:43-46) The cam handle 70 is rotated to the crank position shown in FIG. 3 and the camshaft is rotated thereby rotating the cams 60 and lifting the pins 61 to the opening 62 in the tube 18. (3:46-49) This lifts the locking plate 17 inside the core which is placed on the machine to engage the inner surface of the core. (3:49-51) The specification also states that appropriate means such as a ratchet means or pawl and detent means may be utilized to hold the crank handle 70 or the crank shaft 50 in a locked position. (3:51-54) In practice, the camshaft 50 may have a sufficiently tight fit in the sleeves 51 and 55 so that such additional locking means may not be necessary. (3:54-57) Ostensibly, this additional apparatus is provided within the cantilevered tube to prevent a core so disposed thereupon from sliding or rotating, thereby protecting the fiberboard core during the slabbing process.

Applicants appreciate the Examiner's opinion regarding Applicants' understanding of the instant rejection. However, Applicants are under the impression that the Examiner has not carefully read the *McCay* reference, as it can be clearly seen that the additional apparatus required within the cantilevered tube is both an integral and a necessary part of the disclosed invention. Merely inserting the side supports 7 and 8 of the *Esping* reference to lift the core cannot be considered or easily provided substitution. In fact, it is inconceivable as to how the *Esping* reference can be combined with, or in fact substituted for, the *McCay* apparatus. There clearly is no motivation within either the *McCay* or *Esping* references to provide for the substitution of an *Esping*-like vice into the *McCay* slabbing apparatus having the core holding mechanism. To this end, Applicants agree with the Examiner that there is no such motivation "which is something that *McCay* currently lacks." (July 31, 1008 Office Action, p. 5, Para. 5)

Respectfully, it appears to Applicants that the Examiner is completely obviating the teaching, suggestion, or motivation test provided by the Federal Circuit. No less than the BPAI has concluded that, "We recognize that 'the [obviousness] analysis' need not seek out precise teaching directed to the specific subject matter of the challenged claim, for a court can take a count of the inferences and creative steps that a person of ordinary skill in the art would employ." (Appeal 2008-1092, p. 6) (citing *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)). The Board continues, "However, *KSR* also teaches that an invention 'composed of several elements' is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* (citing *KSR* at 1741) The Board continues, "There must be 'a reason' that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.*

It is abundantly clear to Applicants that the *McCay* reference goes an exceptionally long way to require that the cantilevered tube is a necessary part of the disclosed invention. This is because it is critical that the core remain in a fixed position with respect to the drive unit and carriage device. (3:51-66) As stated previously, the side supports of the *Esping* reference do nothing to fix the core with respect to the carriage of the *McCay* reference. Likewise, for the reasons stated previously, feeding cores onto the cantilevered tube of the *McCay* reference is not the same as providing

cores to an apparatus such as that disclosed by *Esping*. Utilization of the side supports of the *Esping* reference to position a core onto the *McCay* cantilevered tube 18 would likely provide a catastrophic drop onto the floor or other supporting structure of the roll to be slabbed upon removal of one or more of the side supports. Thus, it should be abundantly clear that the *McCay* reference, in view of the *Esping* reference, does not and cannot teach, disclose, or even provide a modicum of a suggestion to each and every element of Applicants' claimed invention. In particular, the *McCay* and *Esping* references, alone or in combination, do not disclose or suggest Applicants' claimed apparatus for slabbing a roll. Accordingly, the rejection of the instant claims under 35 U.S.C. §103(a) over the *McCay* and *Esping* references should be withdrawn.

Claims 1, 3-5, 9, 11-12, and 16 have been finally rejected under 35 U.S.C. §103(a) over Pyron, et al., U.S. Patent No. 5,759,350 in view of Pienta, U.S. Patent No. 5,308,217. Additionally, Claims 1, 3-7, 9, 11-14, 16, and 18-19 have been finally rejected under 35 U.S.C. §103(a) over *Pyron* in view of *Pienta* and further in view of *McCay*. Previous arguments made with regard to the *Pyron*, *Pienta* and *McCay* references remain in effect but will not be repeated for the sake of brevity. Applicants again respectfully traverse these rejections and request the Examiner to consider the following additional matters that clearly distinguish Applicants' claimed invention as presented over the *Pyron*, *Pienta* and *McCay* references, alone or in combination.

The *Pyron* reference discloses that the spool 15 of unwanted paper 20 is mounted via step 35 on a pair of spaced apart rails 37. (5:41-43) This would presume then that a bar pipe or other object must be inserted into the core of the roll and then disposed between two spaced apart rails 37, as shown in Fig. 4 of the *Pyron* reference. This is not what Applicants claim as their invention. It is clearly stated in Claim 1 that Applicants' transport element comprises **a pair** of roll engaging elements capable of penetrating engagement of the core. A singular bar, as provided by the *Pyron* reference, does not constitute a pair of roll engaging elements as required by Applicants' claim. Further, the spaced apart rails 37 are fixed in position and are incapable of movement relative to the core. Therefore, it stands to reason that the roll engaging portions of the *Pienta* and *McCay* references cannot be used in concert with a fixed device. Further, the cantilevered

tube of the *McCay* reference does nothing to repair the deficiencies clearly present in both the *Pyron* and *Pienta* references.

Since it is evident that the *Pyron* reference requires a singular insert, it is difficult to understand how the roll chucking apparatus, such as that disclosed by *Pienta* or the *McCay* apparatus, can be used in junction thereof. The *Pienta* reference requires movement of each of the chucking devices and does not provide for the disposition of the chuck and core apparatus onto the fixably spaced supports 37 present in the *Pyron* reference. Further, insertion of a bar into the core of a roll to be slabbed, as is required by the *Pyron* reference, would necessarily obstruct the resulting core access points so necessary for the *Pienta* reference. If the core holes are obstructed, one must ask how the roll chucks of the *Pienta* reference can access the internal portion of the core so necessary for operation of that apparatus.

Further, if one were to assume, *arguendo*, that the core 15 of the *Pyron* reference having the unwanted paper 20 disposed thereon is directly positioned upon the spaced apart rails 37, one of skill in the art is likely to understand the removal of the unwanted paper 20 could not be possible. This is because direct positioning of the spool 15 of unwanted paper 20 upon the spaced apart rails 37 would necessarily dispose a significant amount of the unwanted paper 20 between the spool and the spaced apart rail 37. This would clearly render the *Pyron* apparatus inoperable. In other words, it is difficult to see how elements that ostensibly internally engage a spool of unwanted paper, such as those envisioned by the *Pienta* and *McCay* references, could be fashioned to operate with the *Pyron* reference. Again, the Examiner has failed to provide any clear or particular suggestion of combinability with any of the references cited that would render Applicants' instant claims obvious. There clearly is no motivation to combine the teachings of the *Pyron*, *Pienta* and *McCay* references to render the instant invention obvious. As is consistent with the *KSR* ruling, an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *See* BPAI Appeal 2008-1092, p. 6 (citing *KSR Int'l. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007)) There clearly must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.*

Applicants respectfully believe that the *Pyron* reference, alone or in combination with any of the *Pienta* or *McCay* references, does not, and cannot, teach, disclose, or provide even a modicum of suggestion for each and every element of Applicants' claimed invention. In particular, the combination of the *Pyron*, *Pienta* and *McCay* references cannot be construed in any reasonable way to teach, disclose, or even provide a modicum of suggestion for Applicants' claimed apparatus for a slabbing roll. Accordingly, the instant rejection of the claims under 35 U.S.C. §103(a) over the *Pyron*, *Pienta* and *McCay* references should be summarily withdrawn.

CONCLUSION

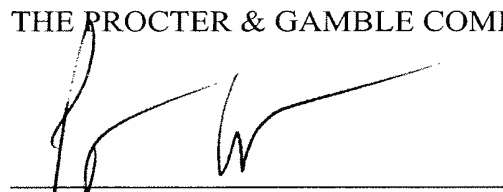
Based on the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512, and no fee is believed due. However, if any additional charges are due, the Examiner is hereby authorized to deduct such charge from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

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